

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Appln: Todd Sarnstrom
Serial No.: 09/996,158
Filed: November 28, 2001
For: REGISTRATION CAM FOR A PRINTING PRESS
Patent Office: Marvin P. Crenshaw
Attorney: Gerald E. Helget
Attorney Docket No.: 23896.305
Additional Fees: Charge to Deposit Account No. 02-3732

Mail Stop Appeal Brief-Patents
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TRANSMITTAL COVER LETTER

Enclosed for filing, please find the following:

1. An original and two copies of Applicant's Appeal Brief (7 pages) and Appendix (2 pages); and
2. A check in the amount of \$160.00; and
3. Postcard receipt.

Respectfully submitted,

Dated: 8/22/03

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By Katy Sathre
Dated August 22, 2003

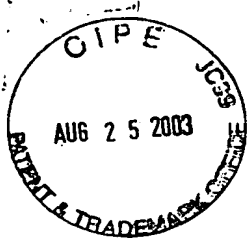
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

#9 Appeal
Brief
9-12-03
L. Spruell

Re. Appellant: Todd Sarnstrom
Serial No.: 09/996,158
Filed: November 28, 2001
For: REGISTRATION CAM FOR A PRINTING PRESS
Patent Office: Marvin P. Crenshaw
Group: 2115
Attorney: Gerald E. Helget
Attorney Docket No.: 23896.305
Additional Fees: Charge to Deposit Account 02-3732

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Sir:

APPELLANT'S APPEAL BRIEF

Appellant by his attorney submits three copies of this Appeal Brief, pursuant to the Office Action mailed April 8, 2003 and 37 C.F.R. § 1.192 in furtherance of the Appeal, the notice of which was filed with the United States Patent and Trademark Office (the Patent Office) on June 23, 2003.

CERTIFICATE OF MAILING

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By Katy Sathre
Date August 22, 2003

I. REAL PARTY IN INTEREST

The real party in interest is Jostens Corporation having a principal place of business at 110 Beasley Road, Cartersville, Georgia 30120. Jostens Corporation is the current owner of the subject matter of U.S. Patent Application Serial No. 09/174,868 by an assignment from the inventor of the invention, Todd Sarnstrom, dated July 8, 2003 and mailed for recording with the U.S. Patent and Trademark Office on July 15, 2003. The reel and frame number have not yet been assigned by the U.S. Patent and Trademark Office.

II. RELATED APPEALS AND INTERFERENCES

This application is not subject to any related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1 to 12 were originally filed in the present application. Claims 1 to 12 are pending in the present application. Claims 8 to 10 have been allowed. Claims 3 to 6 have been objected to but the Patent Office has indicated that these claims would be allowable if rewritten in independent form to incorporate all of the limitations of the base claim and any intervening claims. Claims 1, 2, 7, 11 and 12 have been rejected. The rejection of Claims 1, 2, 7, 11 and 12 is the subject matter of the present appeal.

In the first Office Action mailed November 4, 2001, the Patent Office allowed Claims 8 to 10, objected to Claims 3 to 6, and rejected Claims 1, 2, 7, 11 and 12. In a Response dated January 6, 2003, Appellant traversed the rejection of Claims 1, 2, 7, 11 and 12 and the objection to claims 3 to 6. In a final Office Action mailed April 8, 2003, the Patent Office maintained its rejection of Claims 1, 2, 7, 11 and 12 and objection to Claims 3 to 6.

IV. STATUS OF AMENDMENTS

No amendments have been made to the present application.

V. SUMMARY OF THE INVENTION

The present invention provides a novel registration cam (40) for a printing press (10). Specification Page 2, lines 2 to 3. A registration cam is a component of the registration assembly of a platen press. The register assembly (16) is attached to the platen assembly (12)

of a printing press (10) to position print media (90), such as paper, on the platen assembly (12). Specification Page 6, lines 2 to 20. Generally, the register assembly (16) transversely aligns the print medium to either the right for a "gear side" register or to the left for an "operator side" register on the platen assembly (16). Id. The selection between a gear side or an operator side register is dictated by the nature of the particular print job. Id. The registration cam presents a profile which follows a gripper bar (26) of the registration assembly as the gripper bar (26) moves between a first position and a second position to register the print medium (90). Id. Prior to the present invention, an alternative registration cam had to be installed in the registration assembly to switch between a gear side register and an operator side register. Specification Page 2, lines 4 to 18. A registration cam (40) in accordance with the present invention includes at least one arm (43, 44, 45) that can be switched between one of two positions without being removed from the printing press (10). Specification Page 6, line 21 to Page 10, line 24. Accordingly, the present invention, among other things, simplifies the process of switching between a gear side register and an operator side register. Specification Page 3, line 14 to Page 4, line 21.

As particularly recited in the claims, the present invention provides a registration cam (40) for a printing press (10). Specification Page 11, line 2 to Page 13, line 2.

In one aspect covered by Claim 1, the registration cam (40) includes a body (42) and at least two cam arms (44, 45) extending outward from the body (40) an exemplary embodiment of which is generally illustrated in Figures 2A to 6. Specification Page 11, lines 2 to 4.

In another aspect covered by claim 12, the registration cam (40) includes a body (42) and at least one cam arm (43), cam arm (43) including at least a first face (46) and a second face (47) an exemplary embodiment of which is generally illustrated in Figures 7A and 7B. Specification Page 12, line 24 to Page 13, line 2. The first face (46) having a first profile and the second face (47) having a second profile and the at least one cam arm (43) secured to the body (42) to permit the cam arm (43) to be rotated between at least a first position and a second position. The at least one cam arm (43) secured to the body to permit the arm to be rotated between at least a first position and a second position. Id.

In yet another aspect covered by claim 11, the registration cam (40) includes a first face (46) and a second face (47), with the first face (46) having a first profile and the second

face (47) having a second profile each of the first profile and second profile conferring distinct movement characteristics to the register cam (40). In this aspect, the first face (46) and the second face (47) are selectable while the register cam (40) remains secured to the printing press (10). Specification Page 12, lines 19 to 23.

VI. ISSUES

Whether or not claims 1, 2, 7 and 12 are anticipated 35 U.S.C. § 102(b) by U.S. Pat. No. 4,987,448 by Chikama (the '448 patent).

Whether or not Claim 11 is anticipated under 35 U.S.C. § 102(b) by U.S. Pat. No. 4,959,910 by Hamilton (the '910 patent).

VII. GROUPING OF CLAIMS

Claims 1, 2, 7 and 12 stand or fall together

Claim 11 stands alone.

VIII. ARGUMENT

I. Claims 1, 2, 7 and 12 are novel under 35 U.S.C. § 102(b) over the '448 patent:

The Patent Office rejected Claims 1, 2, 7 and 12 under 35 U.S.C. § 102 as anticipated by the '448 patent. The Patent Office found that the '448 patent "teaches a register cam (Fig. 2) for use in a printing press comprising a body (15) and at least two cam arms (11B and 11C) extending outward from the body." See Final Office Action mailed April 8, 2003 at Page 3. Appellant respectfully submits that the Patent Office's findings that the '448 patent discloses a register cam for use in a printing press comprising a body and at least two cam arms extending outward from the body is erroneous. Nowhere does the '448 patent teach or suggest a registration cam as described and claimed by Appellant.

The '448 patent relates to printers for printing on a continuous recording form not a "printing press." The structures referenced by the Patent Office as anticipating a registration cam are components of the "skewing detection mechanism 10" taught by the '448 patent. A skewing detection mechanism detects transport malfunctions of the continuous recording form. Particularly, a skewing detection mechanism detects when the paper is skewed or, in other words, detects when the continuously fed form becomes misaligned in the printer. As

taught and claimed by Appellant, the claimed registration cam translates the motion of the gripper bar to selectively position a cut sheet of paper on a printing press. Thus, the skewing detection mechanism of the '448 patent is unrelated to and should not anticipate the "registration cam for a printing press" taught and claimed by Appellant.

A reference much teach each element and limitation of a claimed invention for a rejection under 35 U.S.C. § 102(b) to be proper. The '448 patent does not teach or suggest a registration cam for use with a printing press as taught and claimed by Appellant. Accordingly, the Patent Office has erred in rejecting Appellant's application under 35 U.S.C. § 102(b).

At the outset, a skewing mechanism is not a registration cam as suggested by the Patent Office. The '448 patent does not teach or suggest registering individual sheets of paper or other print media on a printing press using a register cam as is disclosed and claimed by Appellant nor does the '448 patent teach or suggest the solution disclosed and claimed by Appellant.

The Patent Office contends that the '448 patent "teaches a register cam (Fig. 2) for use in a printing press comprising a body (15) and at least two cam arms (11B and 11C) extending outward from the body." FINAL OFFICE ACTION at Page 3. However, the Patent Office has taken the liberty of changing the wording associated with the numbered components to correspond with Appellants distinct claimed invention. Properly labeled, the '448 patent teaches a skewing detection mechanism 10 with, among other components, a continuous sensing arm 11B and push arm 11C. The continuous sensing arm and push arm are not cam arms as taught and claimed by Appellant. Nowhere does the '448 patent teach or suggest a cam arm for following a gripper bar. Accordingly, Appellant submits that the '448 patent does not teach or suggest a registration cam to position a printing medium on a printing press as disclosed and claimed by Appellant.

Particularly, the '448 patent teaches a "skewing detection mechanism 10" and its associated components of a "pickup 11" slidably and pivotally secured to a "shaft 15." The pickups (11) in their entirety include a boss (11A), a continuous sensing arm (11B) and a push arm (11C). The sensing arm 11B function to follow the continuous recording form as it is fed through the printer. The sensing arm 11B moves in response to loosing contact with paper in order to sense with the paper is misaligned or skewed. The push arm 11C of the '448

patent functions to support a push bar 12 against gravity. The push arm 11C releases the push bar 12 to shut down the printer when the sensing arm loses contact with the paper. This combination of elements referenced by the Patent Office functions to detect the skewing of continuous recording form in a printer fed with a continuous sheet of paper and, in response, to shut down the printer.

As discussed above, Appellant's cam arms (43, 44, 45) are caused to move by contact with the gripper bar and transfer that motion to a register gauge 30 to position a sheet of paper. The sensing arm (11B) and push arm (11C) do not function to register a print medium like the cam arms (43, 44, 45) disclosed and claimed by Appellant. When sensing arm (11B) loses contact with the continuous recording form, the push bar (12) is released from push arm (11C). In essence, sensing arm (11B) and push arm (11C) function as a lever and support, respectively. The cam arms as disclosed and claimed by Appellant provides for the alternative registration of paper on a printing press without requiring the switching of the replacement of the registration cam in the registration assembly. Thus, the '448 patent does not teach a registration cam for a printing press or one or more cam arms as disclosed and claimed by Appellant. Accordingly, neither the sensing arm 11B or the push arm 11C anticipates a cam arm (43, 44, 45) as taught and claimed by Appellant.

Further, the Patent Office has chosen not to consider the preamble in defining the scope of the claims in finding Appellant's claims anticipated. The Patent Office expressly states that "a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 U.S.P.Q. 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 U.S.P.Q. 478, 481 (CCPA 1951)." Final Office Action mailed April 8, 2003 at Page 4. Respectfully, Appellant submits that the body of Appellant's claims do depend on the preamble limiting the invention to a registration cam for a printing press.

Further, Appellants point out that "the determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim. *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002); see also M.P.E.P. § 2111.02. The Federal Circuit has found that "if the claim preamble is 'necessary

to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999); See also *Kropa*, 187 F.2d at 152, 88 USPQ at 481 (A preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article produced.); see also M.P.E.P. § 2111.02. Similarly, in Appellant's application, the preamble reciting "a registration cam for a printing press" is 'necessary to give life, meaning, and vitality' to the body and cam arms of Appellant's claims and should be deemed essential to point out the invention defined by the claims because it is only by this phrase that it can be known that the subject matter of the claims is comprised of a registration cam for a printing press.

Therefore, the Patent Office's rejection of Claims 1, 2, 7 and 12 as anticipated by the '448 patent is inappropriate.

Accordingly, Appellant respectfully requests that the rejection of Claims 1, 2, 7 and 12 under 35 U.S.C. § 102(b) be overturned.

II. Claim 11 is novel under 35 U.S.C. § 102(b) in view of the '910 patent

The Patent Office rejected Claim 11 under 35 U.S.C. § 102(b) as anticipated by the '910 patent. The Patent Office found that the '910 patent "teaches a register cam (Fig. 2A) for a printing press comprising at least a first face (front side of 14) and a second face (back side of 14) with said first face having a first profile and the second face having a second profile." Further, the Patent Office found that this structure presented by the '910 patent is sufficient to reject Appellant's Claim 11 "since the language concerning the faces being 'selectable' does not set forth any structure and is hence not sufficient to patentably distinguish the claimed invention from the prior art." Appellant respectfully disagrees.

The Federal Circuit has expressly found that functional claim language can be considered in evaluating a claim relative to the prior art. Lewmar Marine, Inc. v. Varient, Inc., 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987) ("so that" functional clause of claim renders

reference non-anticipating); Raytheon Co. v. Roper Corp., 220 U.S.P.Q. 592 (Fed. Cir. 1983) (to the patentee's disadvantage, since it rendered the claimed combination inoperative under 35 U.S.C. § 101). The M.P.E.P. supports this position at § 2173.05(g) stating, *inter alia*:

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it *fairly conveys* to a person of ordinary skill in the pertinent art *in the context in which it is used*. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular *capability* or purpose that is served by the recited element, ingredient or step. (emphasis added)

Appellant respectfully submits that the "selectable" limitation "fairly conveys" the novel "capabilities" of Appellant's invention to a person of ordinary skill in the art as used in the claim and as set forth in the specification and figures.

Accordingly, Appellant respectfully requests that the rejection of Claim 11 under 35 U.S.C. § 102(b) be overturned.

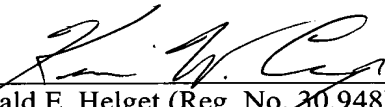
In view of the foregoing, Appellant asks the Board to overturn the Patent Office's rejections and allow all claims

IX. APPENDIX

The appealed claims are presented in the attached appendix.

Respectfully submitted,

Dated: 8/22/23

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APPENDIX

1. A register cam for use on a printing press, comprising:
a body; and
at least two cam arms extending outwardly from the body.
2. A register cam, as in Claim 1, further comprising the at least two cam arms movably connected to the body to permit the at least two cam arms to be locked in one of a first position and a second position relative to the body.
3. A register cam, as in Claim 2, further comprising:
the body including longitudinal bore and a transverse cavity; and
the at least two can arms secured to one another at an axis, the axis further including a detent and a rod secured to the axis and extending from the axis, the rod extending into the longitudinal bore of the body to rotatably secure the at least two cam arms to the body and the detent shaped to be received within the transverse cavity to lock the at least two cam arms in one of the first position and the second position relative to the body.
4. A register cam, as in Claim 3, further comprising a set collar secured to the rod of the at least two cam arms to retain the shaft within the longitudinal bore of the body.
5. A register cam, as in Claim 4, the body further comprising a slot, the slot being coextensive with at least a portion of the longitudinal bore of the body wherein the set collar is positioned within a slot; and further comprising a compressible element secured between a first end of the slot and the set collar to compressionally secure the detent within the transverse cavity of the body to prevent the rotation of the at least two cam arms relative to the body around a longitudinal axis of the rod.
6. A register cam, as in Claim 5, wherein the compressible element is a coil spring positioned about the rod between the first end of the slot and the set collar.
7. A register cam, comprising:
a body;

a first cam arm extending from the body;
a second cam arm extending from the body; and
a means for positioning the first cam arm and the second cam arm relative to the body.

8. A printing press, comprising:

a platen; and

a register assembly secured to the platen, the register assembly including a register gauge connected to a register cam, the register cam having a first cam arm and a second cam arm, one of the first cam arm and the second cam arm contacting a gripper bar to transversely move the register gauge over the platen to align a printing medium on the platen prior to printing.

9. A printing press, as in Claim 8, further comprising a register rod secured to the register gauge and secured to the register cam to connect the register gauge to the register cam.

10. A printing press, as in Claim 9, wherein the register cam is adjustable between a first position and a second position, the first cam arm contacting the gripper bar when the register cam is in the first position and the second cam arm contacting the gripper bar when the register cam is in the second position.

11. A register cam for a printing press, comprising at least a first face and a second face, with first face having a first profile and the second face having a second profile each of the first profile and second profile conferring distinct movement characteristics to the register cam, and with the first face and the second face being selectable while the register cam remains secured to the printing press.

12. A register cam for use on a printing press, comprising:

a body; and

at least one cam arm extending from the body, the at least one cam arm including a first face and a second face, the first face having a first profile and the second cam having a second profile and the at least one cam secured to the body to permit the arm to be rotated between at least a first position and a second position.